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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,299	07/18/2003	Arvind N. Shah	679.0044USU	7273

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EXAMINER

KANTAMNENI, SHOBHA

ART UNIT	PAPER NUMBER
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1617

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/27/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/622,299	Applicant(s) SHAH ET AL.	
	Examiner Shobha Kantamneni	Art Unit 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5-14 and 21-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) NONE is/are allowed.
- 6) ☒ Claim(s) 1, 5-14, 21-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/18/2006 has been entered.

Applicant's amendment filed on 10/18/2006, wherein claims 1, and 14 have been amended, and claims 30-31 have been canceled.

Applicant's amendment is sufficient to overcome the rejection of claims 14, 21-31 under 35 U.S.C. 112, second paragraph, as being vague for failing to particularly point out, and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 5-14, 21-29 are pending, and examined herein.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 1617

Claims 1, 5-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Brieva et al. (US 5,800,816, PTO-892 of record).

Brieva et al. disclose compositions for topical application to skin comprising a pearlescent component bismuth oxychloride, and organic pigments including D&C and FD&C blues, browns, greens, oranges, reds, yellows, etc. and inorganic pigments including iron oxides, ultramarine, and chromium or chromium hydroxide colors, etc. See column 4, lines 45-55, lines 59-60; column 5, lines 14-23; column 6, lines 65-column 7, line 5. Pearlescent component, and pigments are present in an amount of 0.1 to 70 % by weight. See column 4, line 48. The composition is incorporated into a vehicle which is a color cosmetic composition such as lipstick, face powder, blush, eyeshadow, liquid or powder, makeup. See column 4, lines 52-55. It is further disclosed that the composition can be in the form of oil emulsion makeup compositions. See column 6, lines 5-7. A method of making water in silicone emulsion make up composition comprising silicone polymer, cyclomethiocone/dimethicone copolyol; pearlescent ingredient, mica; pigments such as red iron oxide, yellow iron oxide, and water is also disclosed. It is also disclosed that the face powder or mascara composition contains dry particulate matter which is a combination of colored pigments with the powder comprising pearlscent ingredient, such as bismuth oxychloride and mixtures of other ingredients such as zinc stearate, talc, mica etc. i.e colored pigment is bonded to bismuth oxychloride. See column 4, lines 56-column 5, line ;8; column 5, lines 52—55; column 8, EXAMPLE 5. See EXAMPLE 1, column 7, lines 43-55; wherein the particulate matter comprising pigments, and pearlscent ingredient, mice are blended,

Art Unit: 1617

and then added to a cosmetic carrier. An eyeshadow formulation comprising bismuth oxychloride, pigments such as black, yellow, red iron oxides i.e colored pigment bonded to bismuth oxychloride is disclosed in EXAMLE 5, column 9. The composition can comprise from about 0.1-60 % of volatile components which include straight or branched chain hydrocarbons such as isododecane. See column 2, lines 44-46; EXAMPLE 2.

The recitations “wherein said pearlescent component is matched to a natural skin tone benchmark shade”, and “a pigment component that is separately shade-matched to said benchmark shade” in claim 1 is a product-by-process limitation. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious over a product of the prior art the claim is unpatentable even though the prior product was made by a different process. In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (‘Fed. Cir. 1985). See MPEP 21 13.

Regarding, the recitation “wherein a colored pigment is bonded to said bismuth oxychloride in said pearlescent component” in claim 1, the composition disclosed by Brieva et al. comprises a colored pigment and bismuth oxychloride, and thus will inherently contain a colored pigment bonded to bismuth oxychloride

Thus, Brieva et al. anticipate instant claims 1, 5-12.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 5-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Simon et al (US 6,372,202, PTO-1449).

Simon discloses a colored cosmetic compositions for topical application comprising pearlescent agents, such as mica covered with bismuth oxychloride, and pigments. See column 7, lines 38-44; See column 9, EXAMPLE 2 wherein the composition comprises 8 % of bismuth oxychloride, and 5 % of pigment. The composition can be in the form of water in oil emulsion. See column 5, lines 60-63. The composition can be in the form of nail varnish, mascara, eyeliner, lipstick, lip gloss, foundation, powder etc. See column 14, claims 1, 29. A method of preparing the cosmetic composition using pearlescent component bismuth oxychloride is also disclosed. See column 9, lines 30-55.

The recitations “wherein said pearlescent component is matched to a natural skin tone benchmark shade”, “a pigment component that is separately shade-matched to said benchmark shade” in claim 1 is a product-by-process limitation. Even though product-by-process claims are limited by and defined by the process, determination of

Art Unit: 1617

patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious over a product of the prior art the claim is unpatentable even though the prior product was made by a different process. In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 ('Fed. Cir. 1985). See MPEP 21 13.

Regarding, the recitation "wherein a colored pigment is bonded to said bismuth oxychloride in said pearlescent component" in claim 1, the composition disclosed by Simon comprises a colored pigment and bismuth oxychloride, and thus will inherently contain a colored pigment bonded to bismuth oxychloride

Thus, Simon et al. anticipates instant claims 1, 5-9.

Claims 1, 5-10, 13, 14, 21-26, 29 are rejected under 35 U.S.C. 102(e) as being anticipated by Tan et al. (US 6,511,672, PTO-892 of record).

Tan et al. disclose cosmetic composition for topical application to skin comprising a first platelet of alumina treated with metal oxide such as iron-oxide, a second platelet can be selected from mica, bismuth oxychloride, alumina, copper, bronze. See col. 3; line 30-col. 4, line 22. It is disclosed that the two platelets together form the mosaic which gently reflects light and matches the natural color of the skin i.e the pearlescent component is matched to a natural skin tone. See column 3, lines 31-36. The composition comprising the alumina treated with metal oxide, and the second platelet bismuthoxychloride also comprises a standard interference pigments. The preferred interference pigments are pigments of different colors or types combined to blend an

Art Unit: 1617

appropriate shade or intensity of color to match the natural skin tone. See column 4, lines 40-43, line 66, col. 4, line 4 col.5; col.5 lines 49-53. The method of preparing the cosmetic composition by blending the platelets and pigments is also disclosed. See col. 8, claims 1-3. It is further disclosed that the combination of platelets and pigments creates a mosaic of color and optically manipulates light such that the lines, wrinkles, disfigurations and discolorations on the skin appear to substantially vanish and the net effect is the skin appears natural, luminous and flawless. See abstract; column 4, lines 20-21; column 6, lines 15-49; column 8, claims 1,3. Inorganic pigments, and organic pigments are used in the composition. The platelet comprising bismuth oxychloride is present in an amount of 0.1 to 10.0 %, and the pigments are present in an amount of 0.05 to 50 % by weight. See column 4, lines 33-35; column 5, lines 12-15. The makeup products include foundations, blushes, pressed or loose powders, concealers, bronzers, lipsticks, lipglosses. Also the products can be in the form of gels, sticks, water-in oil emulsions, sprays, pressed or loose powders. See column 6, lines 59-66. For liquid foundation a water-in-oil emulsion is preferred, and the oil component comprises a silicone oil. See column 7, lines 4-9; column 8, EXAMPLE 1. Tan et al. also discloses that the pigment is blended with the pearlescent to closely match the natural skin tone. See column 3, lines 56-60.

Regarding, the recitation "wherein a colored pigment is bonded to said bismuth oxychloride in said pearlescent component" in claims 1, and 14 the composition disclosed by Tan et al comprises a colored pigment i.e alumina platelet treated with

Art Unit: 1617

iron-oxide and bismuth oxychloride, and thus will inherently contain a colored pigment bonded to bismuth oxychloride

Thus, Tan et al. anticipates instant claims 1, 5-10, 13, 14, 21-26, 29.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tan et al. as applied to claims 1, 5-10, 13-14, 21-26, and 29 above in view of Breiva et al. (US 5,800,816, PTO-892 of record).

Tan et al. is as discussed above.

Tan et al. does not teach that the silicone emulsion composition therein comprises isodecane, and the amount of isodecane.

Breiva et al. discloses a method of making water in silicone emulsion make up composition comprising silicone polymer, cyclomethicone/dimethicone copolyol; pearlescent ingredient, mica; pigments such as red iron oxide, yellow iron oxide, and water is also disclosed. The composition can comprise from about 0.1-60 % of volatile components which include straight or branched chain hydrocarbons such as isododecane. See column 2, lines 44-46; EXAMPLE 2.

Art Unit: 1617

It would have been obvious to a person of ordinary skill in the art at the time of invention to employ isododecane in the compositions of Tan et al. because Breiva teaches analogous silicone emulsion compositions, useful as make up products containing additives such as isododecane.

It would have been obvious to one of ordinary skill in the art to employ the specific weight percentages of the isododecane as claimed in the instant invention because it is taught by Breiva that water in silicone emulsion make up composition comprising silicone polymer, cyclomethicone/dimethicone copolyol; pearlescent ingredient, mica; pigments such as red iron oxide, yellow iron oxide, and water comprise from about 0.1-60 % of volatile components which include straight or branched chain hydrocarbons such as isododecane. Accordingly, Breiva teaches an analogous art comprising the instant isododecane within the amount ranges as claimed in the instant application. One would have been motivated to add isododecane in the weight percentage of the instant application to the composition of Tan et al. because as taught by Breiva, such preparations are useful as make up products.

It has been held that it is within the skill in the art to select optimal parameters, such as amounts of ingredients, in a composition in order to achieve a beneficial effect. See *In re Boesch*, 205 USPQ 215 (CCPA 1980).

Conclusion

No claims are allowed.

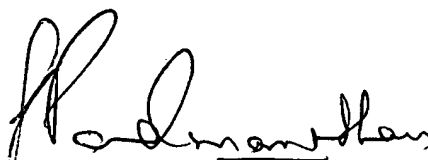
Art Unit: 1617

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shobha Kantamneni whose telephone number is 571-272-2930. The examiner can normally be reached on Monday-Tuesday, Thursday-Friday, 7.30am-3.30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, Ph.D can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shobha Kantamneni, Ph.D
Patent Examiner
Art Unit : 1617



SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER